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TO : Commissioner for Patents
Mail Stop: Appeal Brief - Patent

FROM : Oleg F. Kaplun, Esq. of Fay Kaplun & Marcin, LLP

DATE : October 10, 2007

SUBJECT : U.S. Patent Appln. Serial No. 09/900,335
for *Substituting URL for Attachment in Forwarding Electronic Content*
Phillips Ref.: US 018099

NUMBER OF PAGES INCLUDING COVER : 13

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Attorney Docket No. US018099

IN THE UNITED STATES PATENT AND TRADEMARK OFFICERECEIVED
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Inventor(s) : Kaars
Serial No. : 09/900,335
Filing Date : July 5, 2001
For : Substituting URL for Attachment in Forwarding Electronic Content
Group Art Unit : 2153
Examiner : Philip J. Chea
Confirmation No. : 5618

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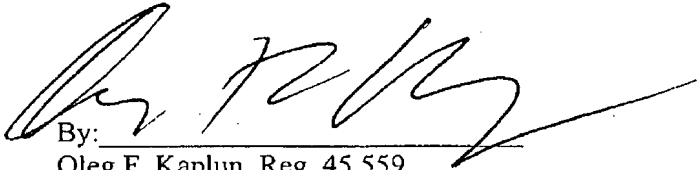
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By: Oleg F. Kaplun, Reg. No. 45,559	Date: October 10, 2007

TRANSMITTAL

Transmitted herewith please find a Reply Brief in response to the Examiner's Answer mailed on August 10, 2007 for filing in the above-identified application. No fees are believed to be required. The Commissioner is hereby authorized to charge any additional required fees to the **Deposit Account of Fay Kaplun & Marcin, LLP No. 50-1492**. A copy of this paper is enclosed for that purpose.

Respectfully submitted,

Dated: October 10, 2007

By: 
Oleg F. Kaplun, Reg. 45,559

Attorney Docket No. US018099

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**RECEIVED
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Inventor(s) : Kaars
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For : Substituting URL for Attachment in Forwarding Electronic Content
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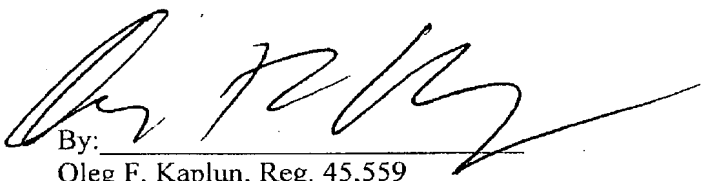
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Mail Stop: Appeal Brief - Patents Commissioner for Patents Alexandria, VA 22313-1450 571-273-8300	
By: Oleg F. Kaplun, Reg. No. 45,559	Date: October 10, 2007

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Respectfully submitted,

Dated: October 10, 2007

By: 
Oleg F. Kaplun, Reg. 45,559

Serial No.: 09/900,335
Group Art Unit: 2153
Attorney Docket No.: US018099

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)

Peter Bernhard Kaars)

Serial No.: 09/900,335)

Filed: July 5, 2001)

For: SUBSTITUTING URL FOR)
ATTACHMENT IN FORWARDING)
ELECTRONIC CONTENT)

Group Art Unit: 2153

Examiner: Philip J. Chea

**Board of Patent Appeals and
Interferences**

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REPLY BRIEF UNDER 37 C.F.R. § 41.41

In response to the mailing on August 10, 2007 of an Examiner's Answer to the Appeal Brief filed May 7, 2007, and pursuant to 37 C.F.R. § 41.41, Appellant presents this reply brief in the above-captioned application.

This is an appeal to the Board of Patent Appeals and Interferences from the Examiner's rejection of claims 1-11 in the final Office Action dated December 6, 2006 as clarified in the Advisory Action mailed March 5, 2007 and further clarified in the Examiner's Answer mailed August 10, 2007. The appealed claims are set forth in the attached Claims Appendix.

Serial No.: 09/900,335
Group Art Unit: 2153
Attorney Docket No.: US018099

1. Grounds of Rejection to be Reviewed on Appeal

I. Whether claims 1-3 and 7-11 are unpatentable under 35 U.S.C. § 102(e) over U.S. Patent Publication No. 2002/0188841 to Jones et al. (Jones).

II. Whether claims 4-6 are unpatentable under 35 U.S.C. § 103(a) over Jones in view of U.S. Patent No. 6,327,656 to Zabetian (Zabetian).

2. Argument

I. The Rejection of Claims 1-3 and 7-11 Under 35 U.S.C. § 102(e) As Being Unpatentable Over Jones Should Be Reversed

In the Examiner's Answer, the Examiner maintained that it would have been obvious to one of ordinary skill in the art that the limitations of claims 1-3 and 7-11 are taught by Jones. The Examiner continues to assert that Jones performs the verifying and contacting steps recited in claim 1. (See Examiner's Answer, pp. 4-5). Appellant continues to disagree with the Examiner's interpretation of Jones as described in the Appeal Brief and does not believe that the Examiner's argument addresses the issues raised in the Appeal Brief. (See Appeal Brief, pp. 6-9). For the sake of brevity, the Appellant will not repeat these arguments, but will maintain the arguments as filed in the Appeal Brief.

However, the Appellant also notes that the Examiner has not shown how Jones teaches the recited substituting step. In fact, the Examiner's Answer contradicts the Examiner's claim that Jones teaches the recited substituting step. Initially, claim 1 recites "contacting a search engine if the content information is available from the at least one source, wherein the search engine determines a location within the data network of the at least one source of the content information and returns an updateable index listing each of the sources of a copy of the content information." With respect to this claim recitation, the Examiner asserts that Jones teaches this recitation and refers to:

the last sentence of paragraph [0042] and paragraph [0043], where a search engine is used to return pointers to content items that

Serial No.: 09/900,335
Group Art Unit: 2153
Attorney Docket No.: US018099

match the search request and the pointers provide the location of the files on the computer network.

(Examiner's Answer, p. 3.)

Claim 1 continues on to recite "substituting for the content information a pointer to the location of the at least one source based on the updateable index of sources returned by the search engine." With respect to this claim recitation, the Examiner asserts that Jones teaches this recitation and refers to "the last sentence of paragraph [0042]." (Examiner's Answer, p. 3).

Thus, the Examiner cites to the exact same disclosure in Jones to teach both the contacting step and the substituting step. The last two sentences in paragraph [0042] of Jones state:

The content index has a searchable index of key words and content tags 132 that are associated with file pointers 134 of files that match the description of the key words/content tags. The file pointers provide the location of the corresponding files on the computer network.

(Jones, paragraph [0042]).

Furthermore, there is no mention in the cited excerpt of a substitution.

Appellant disagrees with the Examiner's conclusion. Where is the recited substituting step taught in Jones? According to the disclosure of Jones, the file pointers (analogized by the Examiner to the recited pointers) are included with the content index (analogized by the Examiner to the recited updateable index of sources). However, claim 1 recites "substituting for the content information a pointer to the location of the at least one source *based on the updateable index of sources* returned by the search engine." How can the content index of Jones be substituted by a pointer based on the information in the context index itself? The answer is that it cannot. The result of the process in Jones is the content index.

That is, the end result of the method recited in claim 1, is the substitution of the pointer for the content information based on the updateable index. In contrast, the end result of

Serial No.: 09/900,335
Group Art Unit: 2153
Attorney Docket No.: US018099

Jones is the content index itself. There is no mention throughout the disclosure of Jones that a further substituting step may be performed.

Thus it is respectfully submitted that Jones does not teach or suggest, any of the recitations of claim 1 including “*verifying* with a plurality of sources throughout the data network whether the content information is available from at least one of the sources other than the sender,” “*contacting* a search engine if the content information is available from the at least one source, wherein the search engine determines a location within the data network of the at least one source of the content information and returns an updateable index listing each of the sources of a copy of the content information” and “*substituting* for the content information a pointer to the location of the at least one source based on the updateable index of sources returned by the search engine.” Because claims 2, 3, and 9 depend from, and therefore include all the limitations of claim 1, it is respectfully submitted that these claims are also allowable for at least the same reasons given above with respect to claim 1. Applicants submit that claims 7 and 8 are also patentable for at least the reasons give above with respect to claim 1. Because claim 10 depends from, and therefore include all the limitations of claim 7, and claim 11 depends from, and therefore include all the limitations of claim 8, it is respectfully submitted that these claims are also allowable for at least the same reasons given above with respect to claims 7 and 8.

Serial No.: 09/900,335
Group Art Unit: 2153
Attorney Docket No.: US018099

II. The Rejection of Claims 4-6 Under 35 U.S.C. § 103(a) As Being Unpatentable Over Jones In View Of Zabetian Should Be Reversed.

In the Examiner's Answer, the Examiner maintained that it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Zabetian in view of Jones in order to teach claims 4-6.

Applicants submit that Zabetian does not cure the above-described deficiencies of Jones with respect to claim 1. Therefore Applicants submit that claim 1 is patentable over Zabetian. Because claims 4-6 depend from, and therefore include all of the limitations of claim 1, it is respectfully submitted that these claims are also allowable for at least the reasons given above with respect to claim 1.

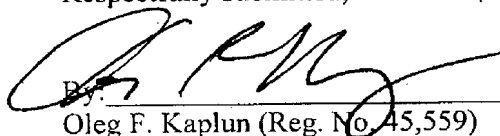
Serial No.: 09/900,335
Group Art Unit: 2153
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3. Conclusion

For the reasons set forth above, Appellant respectfully requests that the Board reverse the final rejections of the claims by the Examiner under 35 U.S.C. § 103(a), and indicate that claims 1-11 are allowable.

Respectfully submitted,

Dated: October 10, 2007


By: _____
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Serial No.: 09/900,335
Group Art Unit: 2153
Attorney Docket No.: US018099

CLAIMS APPENDIX

1. (Previously Presented) A method of controlling communication of content information from a sender to a receiver via a data network, the method comprising:
 - verifying with a plurality of sources throughout the data network whether the content information is available from at least one of the sources other than the sender;
 - contacting a search engine if the content information is available from the at least one source, wherein the search engine determines a location within the data network of the at least one source of the content information and returns an updateable index listing each of the sources of a copy of the content information; and
 - substituting for the content information a pointer to the location of the at least one source based on the updateable index of sources returned by the search engine.
2. (Original) The method of claim 1, being carried out on request of at least the sender or the receiver.
3. (Original) The method of claim 1, wherein the verifying comprises identifying the content based on a watermark embedded in the content.
4. (Original) The method of claim 1, wherein the verifying comprises identifying the content based on a fingerprint of the content.
5. (Original) The method of claim 1, wherein the communication is conditionally being carried out depending on the sender being authorized to communicate the content information.
6. (Original) The method of claim 1, wherein the communication is conditionally being carried out depending on the receiver being authorized to receive the content information.
7. (Previously Presented) A computer readable medium storing a computer program comprising: computer readable code for cooperation with an email application, the computer readable code verifying with a plurality of sources throughout a world wide web whether an

Serial No.: 09/900,335
Group Art Unit: 2153
Attorney Docket No.: US018099

attachment to a specific email to be sent by a user via the world wide web is available from at least one of the sources on the world wide web, contacting a search engine if the attachment is available from the at least one source, wherein the search engine determines a location within the world wide web of the at least one source of the attachment and returns an updateable index listing each of the sources of a copy of the attachment, and substituting for the attachment a pointer to the location of the at least one source based on the updateable index of sources returned by the search engine.

8. (Previously Presented) A computer readable medium storing a computer program comprising: computer readable code for cooperation with an Instant Messaging application, the computer readable code verifying with a plurality of sources throughout a data network whether a file to be sent by a user via the data network is available from at least one of the sources on the data network independent of the user, contacting a search engine if the file is available from the at least one source, wherein the search engine determines a location within the data network of the at least one source of the file and returns an updateable index listing each of the sources of a copy of the file, and substituting for the file a pointer to the location of the at least one source based on the updateable index of sources returned by the search engine.

9. (Previously Presented) The method of claim 1, further comprising updating the updateable index of the search engine with information about the location of the at least one source of the content information.

10. (Previously Presented) The computer readable medium of claim 7, wherein the updateable index of the search engine is updated with information about the location of the at least one source of the attachment.

11. (Previously Presented) The computer readable medium of claim 8, wherein the updateable index of the search engine is updated with information about the location of the at least one source of the file.

Serial No.: 09/900,335
Group Art Unit: 2153
Attorney Docket No.: US018099

EVIDENCE APPENDIX

No evidence has been entered or relied upon in the present appeal.

Serial No.: 09/900,335
Group Art Unit: 2153
Attorney Docket No.: US018099

RELATED PROCEEDING APPENDIX

No decisions have been rendered regarding the present appeal or any proceedings related thereto.